

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 09/922,348	<b>Applicant(s)</b> BORGER ET AL.
<b>Examiner</b> DOHM CHANKONG	<b>Art Unit</b> 2152

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-62.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Jeffrey Pwu/  
Supervisory Patent Examiner, Art Unit 2146

/D. C./  
Examiner, Art Unit 2152

Continuation of 3. NOTE: Proposed amendments to the dependent claims change the scope of the claim and therefore would require further consideration.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant requests documentary evidence that one would not have been inclined to follow Logan's teachings with respect to the location of the translation. Document evidence is only required when the rejection has relied on an Official notice to teach a limitation. With respect to an obviousness rejection, documentary evidence is but one form of the "articulated reasoning" necessary to form the rational underpinning to support the legal conclusion of obviousness. Background knowledge of one of ordinary skill in the art also may be part of the articulated reasoning to support a conclusion of obviousness. Here, support for the conclusion that the artisan would not have been inclined to modify Dames with Logan's teachings comes from the background knowledge for one of ordinary skill in the art. First and foremost, the primary reference Dames already disclosed the claimed limitation of performing the translation at the server device. Applicant arguments would require altering Dames' translation functionality; the rejection is not relying on a conclusion of obviousness to modify the primary reference. The previous response outlined the examiner's reasonings for why one of ordinary skill in the art would not have modified Dames. The rejection relied on Logan to teach an advertisement server. Incorporating the advertisement server into Dames would not have required also incorporating Logan's teaching of performing the translation at the client device. It should be noted that there is no legal requirement that all the teachings of the secondary reference be incorporated into the primary reference. Applicant's arguments only hold weight if Logan taught that in incorporating the advertising database, one must also incorporate the client-side translation functionality. Logan does not teach this and therefore, Dames' server-side translation functionality does not need to be modified. Applicant also argues that the cited references do not teach an advertising server as claimed. The only limitation with respect to the advertising server recites that the advertising server hosts advertisements in text-based format and a web server retrieves the advertisements from the advertising server. The cited references teach this claimed element in the form of Logan's advertising database. The advertising database hosts the advertisements in text format and a web server retrieves the advertisements from the database. Applicant argues that Logan's advertising server fails to disclose means for translating web content to an audio format. There is no limitation in the claims that require the advertising server to translate the web content. Applicant argues other points with respect to the advertising server citing several sections of the specification to distinguish the claimed advertising server from the advertising databases disclosed in Funk and Logan. For example, Applicant points to a section in the specification to clarify the claimed interactive audio advertisements. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to Applicant's other arguments, since prosecution is closed, they will be addressed in response to Applicant's appeal brief or RCE.